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| APPLICATION NO.                                                                                                   | FILING DATE | FIRST NAMED INVENTOR                                 | ATTORNEY DOCKET NO.         | CONFIRMATION NO.       |
|-------------------------------------------------------------------------------------------------------------------|-------------|------------------------------------------------------|-----------------------------|------------------------|
| 10/596,336                                                                                                        | 06/09/2006  | Paulus Mathias Hubertus Mechtildus Antonius Gorissen | NL031443                    | 5399                   |
| 24737 7590 07/30/2009<br>PHILIPS INTELLECTUAL PROPERTY & STANDARDS<br>P.O. BOX 3001<br>BRIARCLIFF MANOR, NY 10510 |             |                                                      | EXAMINER<br>POLTORAK, PIOTR |                        |
|                                                                                                                   |             |                                                      | ART UNIT<br>2434            | PAPER NUMBER           |
|                                                                                                                   |             |                                                      | MAIL DATE<br>07/30/2009     | DELIVERY MODE<br>PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |                                        |  |
|------------------------------|--------------------------------------|----------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/596,336 | <b>Applicant(s)</b><br>GORISSEN ET AL. |  |
|                              | <b>Examiner</b><br>PETER POLTORAK    | <b>Art Unit</b><br>2434                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                      |                                                                   |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                          | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Claims 1-21 have been examined.

#### ***Specification***

2. Applicant is reminded of the proper language and format for an abstract of the disclosure. The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.
3. Additionally, the specification is objected to as failing to address object 110 in Fig. 1. Appropriate correction is required.

#### ***Claim Objections***

4. Claims 1-5, 11-13 and 19-20 are objected to because of the term "for example" in the claim language should not be recited since it does not further identifies the metes and bounds of the invention.

Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. The claimed invention is directed to non-statutory subject matter.

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Claims 1-10, 13, 17-20 are based on Supreme Court precedent and recent Federal Circuit decisions, a 35 U.S.C § 101 process must (1) be tied to a particular machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In re Bilski et al, 88 USPQ 2d 1385 CAFC (2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780, 787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the particular machine to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state. **The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101.** Note the Board of Patent Appeals Informative Opinion Ex parte Langemyer et al.

It is also noted that the broadest reasonable interpretation of a server/system/device could be software that, unless implemented on the computer readable storage medium, is non statutory.

6. Additionally, it is noted that the apparatus/method recite the steps of data manipulation but lacks concrete useful results.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that applicant regards as the invention.

7. Although, As per claims 11-12 and 20-21, in light of other claims and the specification it appears that the steps implemented by a processor (recited in the claim language) are required and in fact, essential to the invention, the claim language uses “an intended use” term “a processor for...” suggesting that perhaps these steps may be unnecessary. As a result, it is not clear whether the steps performed by the processor are required or unnecessary, since a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus if the prior art apparatus teaches all the structural limitations of the claim (Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). For purpose of the further examination the term is considered as the steps performed by the processor are required.

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8. The term “functionally equivalent” cited in claim 1, 5, 10-11, 13 and 19-21 is not understood and the specification does not offer clear definition. For purpose of the further examination the term is treated as “equal”.

Appropriate correction is required.

### ***Conclusion***

#### ***Allowable Subject Matter***

The closest prior art Chow et al.'s “A White- Box DES Implementation for DRM Applications” although directed towards obfuscating a digital signal based on permutations and calculation using a set of functions fails to disclose all the details as claimed by applicant in claims 1-21, and if the claim limitations addressed the 35 USC § 101 and 112 rejection (according to the interpretation used for the purpose of the initial examination) claims 1-21 would be allowable.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

USPN (4751733),

USPN (5838796),

USPN (5949884),

Gabriele Spenger, "Authentication, Identification Techniques, and Secure Containers - Baseline Technologies, "Digital Rights Management, LNCS 2770, pp. 62-80, 2003.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Poltorak whose telephone number is (571) 272-3840. The examiner can normally be reached Monday through Thursday from 9:00 a.m. to 4:00 p.m. and alternate Fridays from 9:00 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Zand can be reached on (571) 272-3811. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Peter Poltorak/

Examiner, Art Unit 2434

/Kambiz Zand/

Supervisory Patent Examiner, Art Unit 2434